REMARKS

The Applicant thanks the Examiner for the Office Action, made final, dated November 29, 2004.

AMENDMENTS

Claims 1 and 9 have been amended to remove any reference to "simultaneous printing".

Claims 1 and 9 now specify that the document and the coded data are printed at the same time using an inkjet printer. Basis for this amendment can be found in original claim 5 (now cancelled) at page 6, lines 1-3 of the specification.

CLAIM REJECTIONS - 35 USC § 112

The Examiner appears to object to the previous claim language of "simultaneously printing". In the Applicant's submission, the terms "printing at the same time" and "simultaneously printing" are entirely analogous and are both supported by the passage identified by the Examiner on page 4, lines 22-25 of the specification.

Nevertheless, in deference to the Examiner's objection, the term "simultaneously printing" has been deleted from the claims.

CLAIM REJECTIONS - 35 USC § 103

The Applicant contests the Examiner's assertion that claim 1 of the present application is obvious from Markowitz (US 5,513,254) in view of Dymetman *et al.* (US 6,330,976) and Ueno (US 5,395,174).

In the first place, Dymetman does not contain any teaching to the effect that coded data and user information should be printed at the same time. The only reference as to how documents are produced in Dymetman is given at column 11, lines 55-65, where it is stated:

> *A coded substrate supplier could produce sheets of paper in different formats for different uses by the publishing industry. Each sheet can be processed through a specialized printing procedure which (1) assigns a fresh page-identifier (and possibly page-id-code) to the sheet, and (2) prints in UV ink machine-readable markings encoding the page-identifier (and possibly page-id-code) on the surface of the sheet.*

> *A publisher can buy these apparently uniformly white sheets and can print visible markings on them using standard ink.* [emphasis added]

Dymetman clearly appreciates the difficulties of mass-producing individually coded sheets using standard printing methods. Consequently, Dymetman recommends that the coded data and the visible markings are printed separately – the coded data being printed by a specialist supplier; the visible marking being printed afterwards by a publisher.

The Examiner makes reference to Figures 14 and 15 of Dymetman in support of his assertion that Dymetman teaches simultaneous printing of coded data and visible markings. However, these Figures merely show pages containing coded data and visible markings, in accordance with the overall teaching of Dymetman. Figures 14 and 15 say nothing about how these pages are produced. The only reference as to how pages are produced in Dymetman is given at column 11, lines 55-65 (and quoted above). It is submitted that Dymetman teaches away from printing coded data and visible markings simultaneously, and gives no encouragement to the skilled person to look for other ways of producing coded documents.

In the second place, it submitted that the combination of Markowitz, Dymetman and Ueno would not lead the skilled person to the invention, as presently claimed. Claims 1 and 9 specify that the document and coded data are printed at the same time using an inkjet printer. An inkjet printer suitable for this purpose is described in detail in the Applicant's copending application PCT/AU00/00561 (see page 2, line 1 and page 5, line 23 of the present description).

None of the prior art teaches or suggests printing visible markings and coded data at the same time using an <u>inkjet printer</u>. In particular, the disclosure of Ueno is limited to <u>thermal printers</u> having a thermal head, an ink ribbon and printing tape (see column 3, lines17-40 of Ueno). Ueno fails to teach an inkjet printer, which is capable of printing coded data and visible markings simultaneously. Accordingly, the skilled person would be unable to arrive at the present invention from the Examiner's combination of documents.

OTHER MATTERS

The Examiner is kindly requested to acknowledge the Applicant's priority claim from Australian Provisional Application No. PQ3632, filed on October 25, 1999.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.
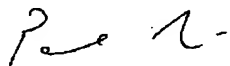
Very respectfully,

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